



PATENT
Attorney Docket No. 101612-5010-US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	Confirmation No. 7173
)	
Glenn McGARRY, <i>et al.</i>)	
)	
Application No.: 09/764,782)	Group Art Unit: 3693
)	
Filed: January 17, 2001)	Examiner: J. Borlinghaus
)	
For: SYSTEM FOR CAPTURING DEAL)	
INFORMATION (<i>as amended</i>))	

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REPLY BRIEF UNDER 37 C.F.R. §41.41

This Reply Brief is in response to the Examiner's Answer dated March 17, 2009, the period for filing this Reply Brief extending through May 18, 2009 (as May 17 is a Sunday).

Hence, Appellants submit that this Reply Brief has been filed timely for consideration.

Appellants' Response

In the Examiner's Answer, the Office asserts that "McErlean discloses the routing of captured information by classification information" and "in other portions, also uses the terms 'tags', 'categories' and 'types' to dictate the identifier to indicate the routing of electronic messages." (Ex. Ans., p. 9, ¶ 5.) As an initial matter, the Examiner provides no citations to the portions of McErlean that specifically disclose or even suggest "'tags', 'categories' and 'types' to dictate the identifier to indicate the routing of electronic messages." (Ex. Ans., p. 9, ¶ 5.) Moreover, the Examiner offers no explanation as to the relevance of these particular portions of McErlean to routing the captured information "based on the one or more product types of the one or more financial products associated with the one or more deals" as clearly required by the claims at issue.

The Examiner asserts in the Examiner's Answer that the "classification information" described in McErlean is used to route captured information. (Ex. Ans., p. 9, ¶ 5.) However, McErlean does not teach "the captured information being routed based on the one or more product types of the one or more financial products associated with the one or more deals" as recited in claims 26, 36, and 46. Instead, for example, McErlean discloses "employ[ing] a text analyzer, such as IBM's Mail Analyzer, to analyse the content of electronic messages in order to classify or categorize, each message according to its content." (See column 1, lines 23-26 of McErlean). In other words, McErlean describes that existing systems route messages using a text analyzer to determine the context of an email message by analyzing the text of the message (*e.g.*, text sequence), categorizing the message based on the analysis (*e.g.*, balance inquiry, request for

transfer, interest rate inquiry), and then routing the message to someone who may be best to handle the message. Thus, the message in McErlean is categorized based on the text of the email message. (See McErlean: col. 1, lines 49-59.) The message in McErlean is not routed based on a tag or message type (*i.e.*, a product type) as required in claims 26, 36, and 46.

The lack of support suffered by the current rejections is further demonstrated by the shifting rationale proffered throughout this prosecution history. Initially, the Examiner ignored 37 C.F.R. § 1.104(c)(2), by failing to articulate in its rejection of claims 26, 36, and 46 the supposedly dispositive passages of McErlean. (See Office Action of 1/10/08, p. 5, ¶ 2.) When this was challenged by Appellants, the Examiner in its next Office Action offered no details, and provided the blanket assertion that McErlean was relevant in its entirety and simply repeated the previous rejections. (See FOA, p. 7, ¶¶ 4-5; p. 8, ¶¶ 1-3.) After making the assertion that McErlean was relevant in its entirety, the Examiner then cited to the Background of the Invention, in McErlean, offering an argument based on the Background of the Invention of McErlean that was never presented in the non-final Office Action. *Id.* The Examiner made the Office Action final.

The Examiner has shifted his position again - arguing for the first time in the Examiner's Answer that the relevant passage of McErlean is provided by the Abstract. (Ex. Ans., p. 8, ¶ 4.) It is respectfully submitted that this explanation was never provided prior to the Examiner's Answer even though Appellants requested that the Examiner explain the relevance of McErlean on several occasions. This previous failure to identify this passage or articulate its relevance is

further and compelling evidence that the disclosure is insufficient as a teaching of these specific limitations.

Please note that Appellants disagree with the Examiner's statement that the "Examiner [has] mapped the claim term 'types' to the McErlean term 'tags.'" The only "mapping" ever identified was provided for the first time in the final Office Action -- and clearly failed to teach or suggest "the captured information being routed based on the one or more product types of the one or more financial products associated with the one or more deals" as recited in claims 26, 36, and 46. (See FOA, p. 7, ¶¶ 4-5; p. 8, ¶¶ 1-3.)

Moreover, with respect to dependent claims 34, 35, 44, 45, 54, and 55, the Examiner asserts that "Appellant has not stated why the Official Notice statement(s) are not to be considered common knowledge or well known in the art, [and] Examiner assumes that Appellant agrees that hedge funds and investment banks are parties to financial transactions" in the Examiner's Answer. Appellants respectfully disagree with these assertions. Appellants properly traversed the Official Notice statement by specifically pointing out the errors in the Examiner's use of Official Notice. See 37 C.F.R. § 1.111(b); FOA, p. 10, ¶ 2. Further, Appellants never agreed with the Examiner that "hedge funds and investment banks [are] parties to financial transactions", and rather pointed out the claims 34, 35, 44, 45, 54, and 55 further define the captured information of the independent claims, which is still not taught by the combination of Sandhu et al. and McErlean. Finally, the Examiner is again being unreasonable and unfair by providing an explanation as to why Sandhu and the use of Official Notice disclose the features of claims 34, 35, 44, 45, 54, and 55 for the first time in the Examiner's Answer. (See Ex. Ans., p

16, ¶¶ 3-4.) In the final Office Action, the Examiner did not rely on this explanation, and instead provided a different basis for why Sandhu et al. and the use of Official Notice disclosed the features of claims 34, 35, 44, 45, 54, and 55. (*See* FOA, p. 6.)

With respect to dependent claims 56-58, the Examiner asserts that Sandhu et al. teaches “internal systems . . . associated with one or more product types” in the Examiner’s Answer. Appellants respectfully disagree with this assertion. FIG. 1 of Sandhu et al. shows the overall system architecture, which includes the CFOWeb System and the Member/ Provider systems. The Member/ Provider systems include various components, such as pricing 40, payments 50, trading 60, confirmation 70, and settlement 80. The CFOWeb System includes servers for trading 160, portfolio management 170, reports 180, analysis 190, calendar server 200, and news and research server 210. (*See also* paragraph [0192] of Sandhu et al.) However, neither the Member/ Provider systems or CFOWeb system in FIG. 1 are “associated with one or more product types” as recited in claims 56-58.

Furthermore, the Examiner improperly states that “Appellant argues that Sandhu fails to teach or suggest ‘the captured information being routed to at least one of the plurality of internal systems.’” (Ex. Ans., p. 17, ¶ 4.) Appellants did not assert this in the Appellants’ Brief. (Appellants’ Br., p. 13, ¶ 2.) Instead, Appellants explained why McErlean, which was relied upon in the final Office Action to teach this feature, did not in fact teach or suggest this feature. *See id.* It is entirely unclear why the Examiner asserts in the Examiner’s Answer that Sandhu et al. teaches “the captured information being routed to at least one of the plurality of internal systems” when the final Office Action admits that Sandhu et al. does not teach this feature. (*See*

Ex. Ans., p. 17, ¶ 5 – p. 18, ¶ 1; FOA, p. 5, ¶ 5.) To reiterate, as discussed in the Appellants’ Brief, McErlean fails to teach or suggest “the captured information being routed to at least one of the plurality of internal systems, where the plurality of internal systems are associated with the one or more product types.” (See Appellants’ Br., pg. 13, par. 2.)

Finally, the Examiner states that it “is uncertain how Appellant[s] can . . . claim that they were blindsided by [a reference’s] relevance” in the Examiner’s Answer. (Ex. Ans., p. 9, ¶ 1.) In response, Appellants respectfully disagree with this assertion as Appellants never claimed they were “blindsided.” Appellants point out that they have made extensive efforts to bring prosecution to a close prior to filing this appeal. For example, Appellants have expended considerable resources in filing multiple requests for continued examination (RCEs), conducting two personal interviews, and filing a pre-appeal brief request for review. Appellants were simply pointing out in the Appeal Brief that it is unfair and unreasonable for the Examiner to make blanket conclusions with no citation of support in one Office Action and then provide the support in the next Office Action to make the Office Action final. (See Appellants’ Br., pp. 6-7.) Similarly, it is unfair and unreasonable for the Examiner to present arguments and/or explanations directed towards the cited prior art for the first time in the Examiner’s Answer.

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CONCLUSION

In view of the foregoing, Appellants respectfully request the reversal of the rejections asserted in the Final Office Action rejection and request allowance of all of the pending claims. If there are any other fees due in connection with the filing of this Reply Brief, please charge the fees to our Deposit Account No. 50-0310.

Respectfully submitted,
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Dated: May 12, 2009

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